

REMARKS

By Office Action dated June 24, 2003, a number of the pending claims stand rejected, reconsideration of which is respectfully requested in view of the following remarks. Claims 3-8 and 58-65 have been cancelled. Claims 1, 2 and 9-57 are now pending.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1, 9, 15, 16, 18, 24-26, 33, 37-41, 46-48, 55 and 57 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of adequate written description for the reasons set forth on page 2 of the Office Action. For purposes of clarity, Applicants will address these grounds of rejections in the order set forth by the Examiner.

(a) *Cyclopentane v. Cyclopentene*. Claim 1 was previously amended to recite “cyclopentane” rather than “cyclopentene”. Support for this amendment may be found in the specification at page 9, lines 6-7, which recites that the second comonomer may be “β-pinene, 5-ethylidene-2-norbornene, methylene cyclohexane [or] methylene *cyclopentane*” (emphasis added). The foregoing list of possible comonomers is also found in pending claims 11, 21 and 43 and cancelled claims 3 and 60, which also recite “cyclopentane” rather than “cyclopentene”. Accordingly, Applicants submit that, in view of the foregoing, it is clear that the initial recitation of “cyclopentene” in claim 1 was merely a typographical error.

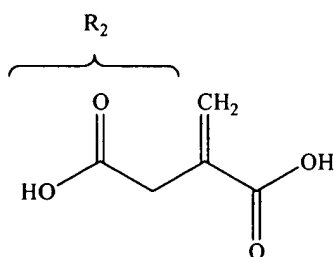
(b) *Introduction of a proviso at the end of step (i) in claim 9*. Claims 9, 18 and 37-41 were previously amended to contain various negative provisos to exclude the dispersants specifically disclosed in Kataoka *et al.* (JP 58-131903). As stated in Applicants’ previous Response, dated March 17, 2003, the use of such negative provisos to excise a species disclosed in the prior art from the scope of a claimed genus is permissible and does not constitute the addition of new matter in view of *In re Johnson*, 194 U.S.P.Q. 187 (C.C.P.A. 1977).

In *In re Johnson*, the applicants claimed a genus of certain thermoplastic polymers and, during prosecution, amended the claims to exclude several known prior art species that fell within the claimed genus. In reversing the Board’s decision that no basis existed in the application for the “limited genus” claimed by the applicants, the CCPA held that:

“The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of § 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute.” *Id.* at 196.

The CCPA further noted that the “specification, having described the whole, necessarily described the part remaining” and that the applicants “are merely excising the invention of another, to which they are not entitled, and are not creating an ‘artificial subgenus’ or claiming ‘new matter’”. *Id.* at 196. Similarly, in the present application, Applicants have merely amended the claims in order to advance prosecution to exclude species disclosed in the prior art from a genus which is fully supported in the specification.

(c) *Introduction of “or CH₂CO₂H” in claim 15.* Claims 15, 25 and 47 were previously amended to clarify that “R₂ is hydrogen, C₁ to C₄ alkyl or CH₂CO₂H”. The CH₂CO₂H moiety was originally inadvertently omitted from such claims. Support for this amendment may be found in the specification at page 8, lines 18-25, which provides that the first comonomer of the present invention may be itaconic acid (shown below), in which R₂ is CH₂CO₂H.



Itaconic Acid

(d) *“Similar other changes in remaining claims”.* In the Office Action, the Examiner also notes that “similar other changes in remaining claims are presented without pointing the support thereof”. Applicants are unclear as to what “similar other changes” the Examiner is referring. Applicants note that two of the changes referenced by the Examiner, namely, the amendments set forth in (b) and (c) above, affect more than the one claim specifically cited by the Examiner. For example, the Examiner objected to the negative proviso

introduced into claim 9. Such negative proviso was also introduced into claims 18 and 37-41. As Applicants have attempted to reference all affected claims in the arguments set forth above, and in the absence of more specific direction by the Examiner to any additional objectionable language, Applicants assume that the foregoing comments sufficiently address the Examiner's concerns.

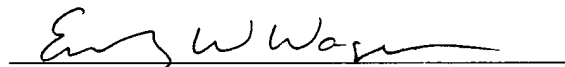
Accordingly, in view of the above arguments, Applicants respectfully submit that the pending claims satisfy the first paragraph requirements of §112 and request that these grounds of rejection be withdrawn.

Allowance of claims 1, 2 and 9-57 is now respectfully requested. A good faith effort has been made to place this application in condition for allowance. However, should any further issue require attention prior to allowance, the Examiner is requested to contact the undersigned at (206) 622-4900 to resolve the same. Furthermore, the Commissioner is authorized to charge any additional fees due by way of this Response, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

Andrew Francis Kirby et al.

SEED Intellectual Property Law Group PLLC



Emily W. Wagner

Registration No. 50,922

EWV:cew

Enclosures:

Petition for Extension of Time
Fee

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

\ 395894